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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		82/1376US	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR		Application Number	Filed
on <u>March 14, 2007</u>		10/024,478	21 December 2001
Signature <u>Electronically filed</u>		First Named Inventor	
Typed or printed name _____		Melesky	
		Art Unit	Examiner
		3637	A. Phi Dieu Tran
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		Kirk A. Damman	
<input checked="" type="checkbox"/> attorney or agent of record.		Typed or printed name	
Registration number <u>42,461</u>		314-444-7783	
		Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.		14 March 2007	
Registration number if acting under 37 CFR 1.34 _____		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:		
James B. Melesky	:		
	:		
Appln. No. 10/024,478	:	Art Unit:	3637
	:		
Filed: 21 December 2001	:	Examiner:	Phi A
	:		
For: INSULATION COVER FOR ATTIC CLOSURES	:	Docket No.:	82/1376US
	:		Formerly: 13811

Commissioner for Patents
Alexandria, VA 22313

Arguments for Pre-Appeal Brief Request for Review

Sir:

As part of the request for pre-appeal brief review, Applicant submits the following arguments, in conjunction with the enclosed Pre-appeal Brief Request for Review form and Notice of Appeal. This filing is timely, as the December 14, 2006 Office Action constituted the final rejection of Applicant's claims, placing the application in position for appeal and pre-appeal briefing. Applicant has studied the Office Action mailed December 14, 2006 and has the following arguments, which are submitted to advise the pre-appeal panel of the fact that no appeal before the Board is necessary, and that the application is allowable, given the straightforward nature of the rejection's impropriety.

Applicant first thanks the Examiner for his statement that claims 17 and 21 are allowed and therefore not subject to this appeal. Further, in these arguments, Applicant respectfully identifies a clearly improper second and final rejection based upon a clearly erroneous rejection for obviousness. Applicant respectfully contends that the Examiner ignores well established law governing the relevance of secondary considerations, and that the Examiner has not shown all

limitations of the pending claims is that the Examiner misreads the principle reference (Waters). The Examiner has therefore failed to present a prima facie case of obviousness.

The Examiner rejected Claims 14 and 27-29 as being obvious over Waters et al. (US 4,344,505) in view of Helbig (US 4,312,423); and Claims 22, 24, 25, and 31-32 as obvious in light of the above combination in further view of Anghinetti et al. (US 3,896,595), Fuller (US 4,281,743), Porter (US 5,628,158), or Daw (US 4,832,153).

Applicant first respectfully points out the Examiner's clear misunderstanding of the law governing the use of secondary considerations. In the December 14, 2006 Office Action, the Examiner calls Applicant's secondary considerations "moot" due to the Examiner's contention that Waters as modified shows all the claimed limitations. (Office Action, p. 9). This is a clear misstatement of the law. Federal Circuit precedent provides that to ignore secondary considerations based on a contention of clear obviousness from the prior art is a clear misstatement of the law. See Demaco Corp. v. F. von Langsdorff Licensing Ltd., 851 F.2d 1387, 1391 (Fed. Cir. 1988) ("The district court held that 'secondary considerations are not significant in this case because first, the prior art so clearly indicates obviousness....' This misstates the law."). Applicant therefore respectfully submits that the Examiner has committed clear error by ignoring Applicant's §132 Declarations showing secondary considerations. Such statements are also summarized in Applicant's Response dated September 29, 2006 ("Response"), at 10-11.

As explained in Applicant's Response, Applicant additionally respectfully contends that rejection of the pending claims under §103 is erroneous because the Examiner misreads the Waters reference as providing a separable cover when it shows no such thing. Applicant respectfully submits that the Examiner inaccurately and inconsistently equates the "cap" of Waters to the removable "closure member" of the present claims.

While the §103 rejection involves Waters in combination with other references, the disclosure of Waters is of particular interest for purposes of this proceeding. Waters only describes caps with inseparable covers. In the first description of the water reference, Waters provides an insulation cap (10) that provides access to the attic opening by 1) hinged movement of a cover (28) that is inseparable from the cap (10). See FIGS. 1-3; col. 2 ll. 54-57 (“A hinge means 14 . . . supports one side or end of the cap 10 to . . . preferably, a portion (cover 28) of the cap.”) (emphasis added). Alternatively, Waters discloses moving the entire cap relative to the attic on hinges (col. 2 ll. 54-57) (“A hinge means 14 . . . supports one side or end of the cap 10 to the attic floor AF . . .”) (emphasis added) or rails (col. 3 ll. 10-15) (“[T]here might be provided a pair of rails along the attic floor and flanges extending outwardly from the cap 10 to provide sliding movement of the cap for purposes of moving the cap to the second opened position.”) (emphasis added).

Waters does not provide for the cover of the instant claims, which require a frame and a detachable closure member, the cover then being placed on the surrounding structure of an existing attic opening. The Examiner’s arguments are flawed in their reliance on the Examiner’s repeated interchanging of elements of the present claims to which the cap 10 of Waters corresponds. For example, the Examiner has asserted that the cap 10 of Waters is in fact the detachable closure member, as is the cover 28. See Office Action dated July 7, 2006, at 3; see also Response at 9; Office Action dated December 14, 2006 at 3 (conflating manipulation of the cap with manipulation of the claimed detachable cover unit). Applicant respectfully submits that comparison of Waters’ cap and cover, as two distinct components, to the three claimed elements of the pending claims clearly indicates the Examiner has failed to make a prima facie case of obviousness as he has not shown all elements of the claims in the references.

Applicant notes that all the remaining claims are dependent on claim 14 and claim 14 only stands rejected in light of the combination of Helbig and Waters. Applicant asserts that none of these secondary references in combination with any of the primary references provides the necessary elements of an existing attic opening, and a cover having a frame and a detachable closure member as discussed in claim 14. As all other claims depend from claim 14, if claim 14 is allowable in light of the references, all remaining claims are also allowable.

Conclusion


In light of the above remarks, Applicant believes there are no further issues regarding the patentability of the pending claims and respectfully request the Panel recognize this clear deficiency and find the second rejection erroneous, eliminating the need for appeal. Applicant further respectfully requests the Panel find the application allowable on the existing claims so that this case can pass on to issue, or, in the alternative, to reopen prosecution.

Applicant submits the fee necessary for the accompanying Notice of Appeal. In addition, the Commissioner is authorized to credit any overpayment or charge any deficiencies necessary for entering this amendment, including any claims fees and/or extension fees to/from our

Deposit Account No. 50-0975.

If any questions remain, Applicant respectfully requests a telephone call to the below-signed attorney at (314) 444-7783.

Respectfully submitted,
Lewis, Rice & Fingersh, L.C.



March 14, 2007

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